

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

**JOINT D. DEL. L.R. 81.2**  
**STATEMENT REGARDING TRANSFER**

Omega Patents, LLC. (“Omega” or “Plaintiff”) and BMW of North America, LLC (“BMWNA” or “Defendant”)<sup>1</sup> hereby file this joint statement pursuant to Local Delaware District Court Rule 81.2 and state as follows:

## I. Background

1. Plaintiff commenced this patent infringement action on May 1, 2020, with the filing of a Complaint in the United States District Court for the Northern District of Georgia (D.I. 1). BMWNA has answered the Complaint on August 3, 2020 (D.I. 43). Discovery has not begun, no *Markman* or claim construction hearing has been held or scheduled, and no trial date was set.

2. BMWNA filed a Motion to Dismiss for Improper Venue on August 3, 2020 (D.I. 43). On December 21, 2020, the District Court for the Northern District of Georgia entered an Opinion, granting BMWNA's motion, and requiring Plaintiff to either (1) voluntarily dismiss the case or (2) select a venue for transfer of the case (D.I. 70). On January 12, 2021, the case was then

<sup>1</sup> Defendant Bayerische Motoren Werke AG has not been served, has not entered an appearance and has not waived its right to contest sufficiency of process and service of process (if/when effected), lack of personal jurisdiction, and any other such arguments as it may deem appropriate. This joint statement is agreed to by Omega Patents, LLC and BMW of North America, LLC only.

transferred to this Court (D.I. 73).

3. On November 23, 2020, BMWNA filed a petition for *inter partes review*, with an institution decision expected by June 1, 2021. BMWNA has filed a Notice of IPR status (D.I. 68).

## **II. Pending Matters Which Require Judicial Action**

Pursuant to Delaware Local District Court Rule 83.1, Omega and BMWNA (the “Parties”) state there are no pending motions requiring disposition by the Court. As such, Omega respectfully requests the Court conduct an initial Rule 16(b) scheduling conference pursuant to Local Rule 16.1(b). BMWNA respectfully requests that the Court defer the Rule 16(b) scheduling process until Omega has either served all defendants or dismissed the unserved defendant from this action, in order to avoid unnecessarily burdening the parties and the Court with additional scheduling disputes in the event that Omega completes service.

Dated: February 10, 2021

Respectfully Submitted,

BAYARD, P.A

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